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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,859	03/18/2004	Benjamin Laux	JDI / 291	6538
26875	7590	10/06/2005	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			CARRILLO, BIBI SHARIDAN	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,859

Applicant(s)

LAUX, BENJAMIN

Examiner

Sharidan Carrillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SHARIDAN CARRILLO
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. In view of the Appeal Brief filed on 8/5/2005, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Michael Barr, SPE
AU1746



Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klier et al. (5811383).

Klier et al. teach a composition comprising a petroleum distillate (col. 4, lines 33-45, a glycol ether (col. 5, lines 3-30), and a C1-C4 ester having a carbon chain length of less than 18 (col. 4, lines 58-63). In reference to the concentration amounts, Klier et al. teach the organic solvent or a mixture of organic solvents are characterized as containing no more than 2 weight percent water (col. 3, lines 50-55). Claim 1 recites a minimum of a 60% solvent mixture. However, Klier teaches a mixture comprising 98% organic solvent (s) and 2 percent water. Klier fails to teach the concentration of the or the ester. It would have been within the level of the skilled artisan to have adjusted the concentrations since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 105 USPQ 233, 235 (CCPA 1955). Concentration limitations are obvious absent a showing of criticality. *Akzo v. E.I. du Pont de Nemours* 1 USPQ 2d 1704 (Fed. Cir. 1987).

In reference to the vapor pressure, the limitations are a property of the

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composition. Therefore, since Klier et al. teach the same composition as the instantly claimed invention, one would reasonably expect the composition of Klier et al. to possess those properties, absence of a showing otherwise. In reference to claim 2, refer to col. 4, lines 32-45. In reference to claim 3, refer to col. 5, lines 3-29. In reference to claims 4-6, refer to col. 4, lines 58-61.

Response to Arguments

5. Applicant argues that Klier teaches an organic solvent blend of less than 60% since col. 1, lines 42-43 teaches an aqueous solution having 40-75% water. Applicant further argues that since Klier requires the composition to contain a certain amount of surfactants, the amount of solvent blend has to be less than 60%. The examiner agrees that Klier teaches an aqueous solution comprising less than 60% organic solvent. However, the reference is now being interpreted differently, and as a result, the claims are still being rejected as being unpatentable over Klier. Consequently, prosecution is reopened in view of this new interpretation of the reference. Applicant is only claiming a solvent blend comprising at least 60%. Klier teaches two concepts a) a microemulsion comprising greater than 40% water and less than 60% organic solvent mixture (col. 1, lines 43-53) and b) the less than 60% organic solvent mixture having 98% organic solvent and 2% water (col. 1, lines 50-53). The examiner is no longer relying on the teaching of Klier of a microemulsion comprising greater than 40% water and less than 60% organic solvent mixture. The examiner is relying on the second concept of a

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solvent mixture having 98% organic solvent and 2% water. Therefore, all arguments directed to the 60:40 organic solvent/water are now deemed moot.

6. Applicant argues that Klier does not teach petroleum distillates, but yet admits that the aliphatic hydrocarbons of Klier which could be petroleum distillates. Applicant argues that Klier teaches too many possible combinations. Applicant's arguments are unpersuasive since applicant admits that aliphatic hydrocarbons could be petroleum distillates and applicant has not provided any other definition of what the petroleum distillates could be.

7. Applicant argues that the claimed composition is not a volatile organic compound. Applicant's arguments are not persuasive because they are not commensurate in scope with the instantly claimed invention. Additionally, Klier teaches the same composition mixture as the instantly claimed invention.

Applicant argues that Klier fails to teach 30-60% distillate or 10% of the ester. It would have been within the level of the skilled artisan to have adjusted the concentrations since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 105 USPQ 233, 235 (CCPA 1955). Concentration limitations are obvious absent a showing of criticality. Akzo v. E.I. du Pont de Nemours 1 USPQ 2d 1704 (Fed. Cir. 1987).

8. Applicant argues that it is very difficult to determine the concentration of glycol ether from the teachings of Klier. Applicant is directed to col. 5, lines 35-50 which specifically teaches greater than 15%, but less than 25%.

9. Applicant argues that Klier fails to teach at least 60% distillate, as discussed in element 5 on page 9 of the Appeal Brief. This statement is clearly incorrect since the instantly claimed invention requires only a minimum of 30% distillate.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. Applicant argues a showing of unexpected results and cites Table 2 on page 6 of the instant specification. The examples of Table 2 do not show criticality and unexpected results since the "No VOC solvent blend B", having a three component mixture, removes less grease than a single component composition having d-limonene. Additionally, applicant's arguments are not persuasive because they are not commensurate in scope with the instantly claimed invention. If applicant intends to argue a showing of unexpected results, then the claims should be amended to be commensurate in scope with the Solvent Blend of Table 2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-

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1297. The examiner can normally be reached on M-W 6:30-4:00pm, alternating Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo
Primary Examiner
Art Unit 1746

bsc



SHARIDAN CARRILLO
PRIMARY EXAMINER